

REMARKS

Claims 2, 5, 8, 10-33, and 37 are pending in this application. Claims 17-33 have been withdrawn from consideration, leaving claims 2, 5, 8, 10-16, and 37 remaining. No claims stand allowed at this time.

This application is a Divisional Application of U.S. Patent Application No. 08/485,161, filed June 7, 1995 (hereinafter the "parent application"), now U.S. Patent No. 6,371,199.

1. Objection to the Response Filed as Not Fully Responsive

The Office Action objects to the Response filed September 15, 2003 as not fully responsive to the assertion of a "mistake of fact" which the Examiner believes was made by the Board of Appeal in the Board's Decision.

Applicants previously argued that, on Appeal in the parent application, the Board reversed the Examiner's rejections, on the same arguments and art, in relation to claims raising substantially identical issues.

In the telephone interview conducted on June 8, 2004, it was agreed that, if the issues raised in the outstanding rejections are different from those argued before the Board, then a further response would be required from Applicant. Conversely, if the issues raised are identical to those previously raised before the

Board, then Applicant's Response is fully responsive.

Applicant believes in good faith that the issues presented in the Office Action dated June 13, 2003 are identical or so substantially identical to those presented to, and decided upon, by the Board of Appeals in the parent application, that the doctrine of res judicata precludes further rejection on the grounds previously presented. It was agreed as follows: that the holding of non-responsive amendment would be withdrawn by the Examiner; that the Examiner would review the previous rejections and point out to Applicant the substantive differences between the present grounds for rejection and those ruled upon by the Board; that the Examiner would submit a Request for Information to Applicant; and that Applicant would respond to the Request for Information in good faith, in order to best address the Examiner's concerns, to the extent that the information requested is still available.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the finding that the Response filed on September 15, 2003 is not fully responsive to the Office action dated June 13, 2003.

**2. Rejection of Claims 2, 5, 8, 10-16, and 37 under the
Judicially-created Doctrine of Obviousness-type Double Patenting**

The Office Action dated June 13, 2003 rejects claims 2, 5, 8, 10-16, and 37 under the judicially-created doctrine of obviousness-type double patenting, over claims 1-9 of U.S. Patent No. 6,371,199. While acknowledging that the conflicting claims are not identical, the Examiner asserts that they are not patentably distinct because the present claims "merely recite the invention more broadly than the corresponding claims in USP '199."

Applicant previously traversed this rejection. The traversal is in two parts:

First, as to claims 10-16 and 37, Applicant renews the traversal on the grounds that 35 U.S.C. §121 prevents a double patenting rejection for the following reason: in the parent application, claims 10-33 were subject to restriction and withdrawn. Applicant acknowledges that claims 17-33 have been restricted out and withdrawn in this action, and are not discussed further. The argument against double patenting under 35 U.S.C. §121 properly pertains only to claims 10-16 and 37, not claims 10-33.

Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the obviousness-type double patenting rejection of claims 10-16 and 37.

Second, as to claims 2, 5, and 8, which relate to subject matter relating to methods of cooling a surface by nucleate boiling, as in the parent case, but of broader scope than the patented claims, Applicant hereby clarifies that his previous response is properly construed as an acknowledgment that a Terminal Disclaimer is required, and will be provided, if claims 2, 5, and 8 are allowable over the claims patented in U.S. Patent No. 6,371,199. Applicants respectfully request that the Examiner not make final this double patenting rejection until such time as claims 2, 5, and 8 are allowed, and a Terminal Disclaimer will be submitted at that time, or the conflicting claims will be canceled.

Accordingly, Applicant respectfully requests the Examiner to reconsider and hold in abeyance the rejection of claims 2, 5, and 8 under the doctrine of obviousness-type double patenting.

CONCLUSION

Based upon the above remarks, the presently claimed subject matter is believed to be novel, patentably distinguishable over the prior art of record, and patentably distinct from the claims in U.S. Patent No. 6,371,199. The Examiner is therefore respectfully requested to reconsider and withdraw the rejections of remaining claims 2, 5, 8, 10-16, and 37, and allow all pending claims presented herein for reconsideration. Favorable action with an

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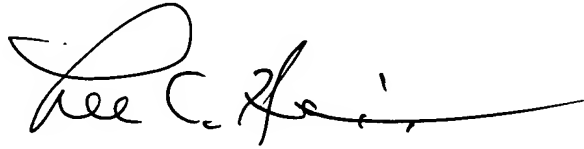
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early allowance of the claims pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned attorney if he has any questions or comments.

Respectfully submitted,

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